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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MORRISON, THOMAS A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,992

Applicant(s)

OUCHI ET AL.

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "the image forming direction" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 13, the recitation, "controlling and guiding, by way of a sheet guide..." is confusing. In particular, it is unclear what is controlled and guided. There appears to be no mention of paper or any other item that is guided.

Also, with the way claim 13 is worded, it is confusing in line 13 as to **what** descends by an empty weight of the special sheet.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 3-4, 8-9 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Publication No. 7-76438.

Regarding independent claim 4, Figs. 1-7 show a sheet feeder (including 2 and 10) in an image forming apparatus (1) including

a manual sheet supply unit (11a) to supply a special sheet and an ordinary sheet, wherein the special sheet is stiffer and smaller in size than the ordinary sheet;

a conveying member (21) to convey the special sheet and the ordinary sheet supplied from the manual sheet supply unit (11a) toward an image forming process unit (e.g., an image recording part in the English Abstract); and

a sheet guide (30) provided between the manual sheet supply unit (11a) and the conveying member (21), having special sheet ribs (Figs. 5 and 6) to control both sides of the special sheet that is inserted and guided by the special sheet ribs (Figs. 5 and 6), and to guide the ordinary sheet by passing the ordinary sheet on an upper surface of the special sheet ribs (Figs. 5 and 6), wherein the sheet guide (30) further has a pressing member (50) between the special sheet ribs (Figs. 5 and 6) that prevents the bending of the central portion of the ordinary sheet by pressing (Fig. 6) the back of the central portion of the ordinary sheet with elastic force, and descends by an empty weight of the special sheet when the special sheet is inserted between the special sheet ribs. By controlling the surface of the sheet in contact with the ribs, the whole sheet (i.e., both sides of the sheet) can be controlled. Regarding the recitation "a pressing member between the special sheet ribs that **prevents the bending of the central portion of the ordinary sheet by pressing the back of the central portion of the ordinary sheet with elastic force, and descends by an empty weight of the special sheet when the special sheet is inserted between the special sheet ribs**", this

bolded portion of the recitation has not been given patentable weight in view of MPEP, section 2114. Specifically, MPEP, section 2114 states that, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." See MPEP, section 2114. Also, the recitation of the special sheet being stiffer and smaller than the ordinary sheet has not been given any patentable weight in view of MPEP, section 2115. MPEP, section 2115 states that, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." See MPEP, section 2115. As such, it is the examiner's position that all of the features of claim 4 are disclosed in Japanese Publication No. 7-76438.

Regarding independent claim 9, Figs. 1-7 and the detailed description of Japanese Publication No. 7-76438 disclose a sheet feeder in an image forming apparatus (including 2 and 10) including

a manual sheet supply unit (11a) to supply a special sheet and an ordinary sheet on a manual sheet supply tray (inside 11a), wherein the special sheet is stiffer and smaller in size than the ordinary sheet;

aligning rollers (21 in Fig. 21 and numbered paragraphs [0005] and [0009]) to align leading edges of the special sheet and the ordinary sheet supplied from the manual sheet supply unit (11a) and convey in the image forming direction (Fig. 7); and

a sheet guide (30) provided between the manual sheet supply unit (11a) and the aligning rollers (21), having special sheet ribs (Figs. 5 and 6) to control both sides of the special sheet and to guide the ordinary sheet by passing the ordinary sheet on upper

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surfaces of the special sheet ribs (Fig. 6), wherein the sheet guide (30) further has a pressing member (50) between the special sheet ribs (Figs. 5 and 6) that prevents the bending of the central portion of the ordinary sheet by pressing the back of the central portion of the ordinary sheet with elastic force, and descends by an empty weight of the special sheet when the special sheet is inserted between the special sheet ribs. As mentioned above with regard to the recitation “a pressing member between the special sheet ribs that **prevents the bending of the central portion of the ordinary sheet by pressing the back of the central portion of the ordinary sheet with elastic force, and descends by an empty weight of the special sheet when the special sheet is inserted between the special sheet ribs**”, this bolded portion of the recitation has not been given patentable weight in view of MPEP, section 2114. Likewise, the recitation of the special sheet being stiffer and smaller than the ordinary sheet has not been given patentable weight in view of MPEP, section 2115. Thus, it is the examiner’s position that all of the features of claim 9 are disclosed in Japanese Publication No. 7-76438.

Regarding claims 3 and 8, Figs. 1 and 7 show that the manual sheet supply unit (11a) supplies the special sheet and the ordinary sheet in a horizontal direction, and the (conveying member (21)/aligning rollers (21)) convey the special sheet and the ordinary sheet in a vertical direction.

Regarding claims 11 and 12, MPEP, section 2115 states that, “[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims.” See MPEP, section 2115. As such, no patentable weight has been given to the special sheet being claimed as a postcard. As such, it is the

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examiner's position that all of the limitations of claims 11 and 12 are met by Japanese

Publication No. 7-76438.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication No. 7-76438 as applied to claims 4 and 9 above, and further in view of U.S. Patent No. 6,102,393 (Kida et al.). Japanese Publication No. 7-76438 discloses that the pressing member (50) is made from plastic film, but does not specifically state that the pressing member (50) is polyester film.

The Kida et al. patent discloses that it is well known to provide a paper-handling device with paper guides (72) that are flexible, in that they are made from Mylar. Moreover, the dictionary definition of "Mylar" is "A trademark for a thin strong polyester film". See page 780 of Webster's II New Riverside University Dictionary. It would have been obvious to one of ordinary skill in the art at the time of the invention, to provide the apparatus of Japanese Publication No. 7-76438 with a pressing member made from polyester, to ensure that the pressing member has sufficient flexibility characteristics, as taught by Kida et al.

Response to Arguments

4. Applicant's arguments filed 08/02/2006 have been fully considered but they are not persuasive. Applicant argues that.

The claims contain the recitation of features that are not present in the device of Japan '438. Newly amended independent claims 4 and 9 recite a sheet guide having special sheet ribs, "wherein the sheet guide further has a pressing member between the special sheet ribs that prevents the bending of the central portion of the ordinary sheet by pressing the back of the central portion of the ordinary sheet with elastic force, and descends by an empty weight of the special sheet when the special sheet is inserted between the special sheet ribs." As shown in Fig. 3 of the specification, the pressing member of this embodiment of the present invention is attached to the sheet guide 13 by a mounting portion 20a. Thus, the claimed invention is directed to a sheet guide having both special sheet ribs and a pressing member attached to the sheet guide. The pressing member prevents the bending of the central portion of the ordinary sheet by pressing the back of the central portion of the ordinary sheet with elastic force. In addition, the pressing member is configured to descend when the special sheet is inserted between the special sheet ribs.

In the Office Action, the Examiner asserts that "the sheet guide (30) further has a pressing member (50) between the special sheet ribs." Instead, Japan '438 teaches the use of two guide structures positioned opposite one another. The first guide structure is a flank guide plate 30 having a plurality of ribs. The second guide structure is a separate guide plate 45 having an elastic body 50 projecting from the guide plate 45. Accordingly, Japan '438 teaches the use of two guide plates, (1) a flank guide plate 30 having ribs and (2) a separate guide plate 45 having an elastic body. (See Figure 4.) As shown in Figure 4, the two distinct guide plates are positioned opposite each other so that a form P moves between the guide plates. Further, Japanese '438 discloses a structure in which the side guide plates provided with the ribs prevent the skewing of standard-size sheets. However, the side guide plates are not configured to prevent skewing when special sheets such as postcards, etc. which are larger in mass and relatively smaller in size than standard-size sheets. Moreover, the Japan '438 reference teaches that the elastic body 50 presses the form P into the flank guide plate 30 ribs. This is shown, for example, in figures 4 and 6.

Thus, Japan '438 fails to teach or disclose a sheet guide having special sheet ribs and a pressing member "between the special sheet ribs that prevents the bending of the central portion of the ordinary sheet by

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pressing the back of the central portion of the ordinary sheet with elastic force, and descends by an empty weight of the special sheet when the special sheet is inserted between the special sheet ribs" as claimed in claims 4 and 9.

In response, independent claims 4 and 9 do not require that the recited "sheet guide" be provided as a single portion or a single part. Rather, it is the examiner's position that the sheet guide can include one or more portions (e.g., including elements 30 and 50 of Japanese Publication No. 7-76438), which can act together as a guide for guiding sheets.

In response to applicant's arguments about the recited function(s) performed by the sheet guide of claims 4 and 9, it is noted that claims 4 and 9 recite, "the sheet guide further has a pressing member between the special sheet ribs that **prevents the bending of the central portion of the ordinary sheet by pressing the back of the central portion of the ordinary sheet with elastic force, and descends by an empty weight of the special sheet when the special sheet is inserted between the special sheet ribs.**" As explained above in the rejections of claims 4 and 9, this bolded portion of the recitation has not been given patentable weight in view of MPEP, section 2114. Specifically, MPEP, section 2114 states that, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of **structure** rather than function." (emphasis added) See MPEP, section 2114. Also, the recitation of the special sheet being stiffer and smaller than the ordinary sheet has not been given any patentable weight in view of MPEP, section 2115. MPEP, section 2115 states that, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims."

See MPEP, section 2115. Accordingly, it is the examiner's position that all of the features of claims 4 and 9 are disclosed in Japanese Publication No. 7-76438.

Conclusion

5. The fact that not all of the claims have been rejected in view of prior art does not mean that such claims contain allowable subject matter. For example, claim 13 is too unclear to determine if this claim does or does not include allowable subject matter.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/13/2006


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